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PATENT  
Customer No. 22,852  
Attorney Docket No. 057230868  
TECH CENTER 1603-2303

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
)  
Jean-Christophe HENRION et al. ) Group Art Unit: 1617  
)  
Application No.: 09/810,628 ) Examiner: M. Willis  
)  
Filed: March 19, 2001 )  
)  
For: COSMETIC COMPOSITION )  
COMPRISING AT LEAST ONE )  
INGREDIENT CHOSEN FROM )  
COMPOUNDS OF FORMULA (I) )  
AND SALTS THEREOF, USE )  
THEREOF AS COLOURING )  
AGENT, AND NOVEL )  
COMPOUNDS OF FORMULAE )  
(IIa), (IIIa), (IVa), (Va), AND (VIa), )  
AND SALTS THEREOF )

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

In response to the Office Action dated August 13, 2002, Applicants respectfully request reconsideration of the subject application in light of the following remarks. In the Office Action, the Office required restriction under 35 U.S.C. § 121 to one of the following groups of claims:

Group I: claims 1-44, drawn to compositions and methods of making the compositions; and

Group II: claims 45-49, drawn to compounds of formula (IIa) to (VIa).

The Office additionally required the election of a single disclosed species of a compound of formulae (I)-(VIa).

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The restriction/election requirement is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject matter of Group I, claims 1-44. Additionally, Applicants elect, with traverse, the compound of example 1. Claims 1-44 are readable on the elected species.

Applicants initially traverse the restriction/election requirement on the grounds that the Office has not shown that there would be a serious burden to examine the claims of Groups I-II together because the search for the compound of formula (I) in claim 1 should encompass a search of the compounds of formula (IIa) to (VIa) of claim 45. Moreover, a search for the compositions of Group I comprising the compound of formula (I) should also encompass a search of the compounds of formula (IIa) to (VIa) of claim 45. Thus, the search and examination of Group I should at least substantially overlap a search for the subject matter of Group II, and a serious burden to examine all the Groups together would not exist.

Moreover, Applicants respectfully submit that they have a statutory right under 35 U.S.C. § 112, second paragraph, to claim the subject matter they regard as their invention as they choose. Issuing a restriction requirement within a claim, such as a compound of a formula chosen from (I)-(VIa), with the idea that Applicants would have to carve up that claim and pursue the nonelected subject matter in a separate application violates this right under section 112. Indeed, the C.C.P.A. has characterized such action as tantamount to a refusal to examine. See, In re Weber, 198 U.S.P.Q. 328 (C.C.P.A. 1978); In re Haas, 198 U.S.P.Q. 334 (C.C.P.A. 1978).

35 U.S.C. § 121 gives the Office authority to promulgate rules designed to restrict an application to one of several claimed inventions when those inventions are found to be

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independent and distinct. 35 U.S.C. § 121, however, does not give the Office authority to reject a particular claim on that basis. Weber at 332.

Thus, in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, the restriction between Groups I and II should be withdrawn.

Finally, Applicants respectfully request that all the claimed species of compounds continue to be examined in this application. If the Office chooses to maintain the restriction/election requirement, Applicants expect the Office, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, i.e., extending the search to a reasonable number of the nonelected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

In view of the foregoing remarks, Applicants respectfully submit that the restriction/election requirement is in error and request that the requirement be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 13, 2002

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